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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/688,618	10/17/2003	Masanori Shinozaki	12844.0048US01	2442
23552	7590	03/07/2006	EXAMINER	
MERCHANT & GOULD PC P.O. BOX 2903 MINNEAPOLIS, MN 55402-0903			PENG, KUO LIANG	
			ART UNIT	PAPER NUMBER
			1712	
DATE MAILED: 03/07/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/688,618	Applicant(s) SHINOZAKI, MASANORI	
	Examiner Kuo-Liang Peng	Art Unit 1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 2/15/06 Response.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) 13 and 14 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 5-8, 10 and 12 is/are allowed.
- 6) ☒ Claim(s) 1-3, 9 and 11 is/are rejected.
- 7) ☒ Claim(s) 4 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>See Continuation Sheet</u> . |

Continuation of Attachment(s) 6). Other: English translation of JP 2002-235016.

DETAILED ACTION

1. The Applicants' response filed on February 15, 2006 was received. Claims 13-14 are withdrawn. Now, Claims 1-12 are pending for consideration.
2. In view of Applicants' argument, Claim rejection(s) under 35 USC 102 and 103 in the previous Office Action (Paper No. 101505) is/are removed.
3. The following Office action is made non-final because of the newly discovered reference, Horikirigawa (JP 2002-235016). Examiner apologizes for cause any inconvenience.
4. The text of those sections of Title 35, U.S. code not included in this action can be found in a prior Office Action (Paper No. 051405).

Claim Rejections - 35 USC § 102

5. Claims 1-2, 9 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Horikirigawa (JP 2002-235016).

For Claims 1-2 and 11, Horikirigawa discloses a coating composition comprising a first thermosetting resin and a carbonized rice bran ceramics derived

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from pulverizing a carbonized mass of a cured product of a rice bran and a second thermosetting resin such as a liquid phenol resin, etc. The first thermosetting resin can be the same as the second thermosetting resin (i.e., a liquid phenol resin) ([0011]-[0013]) Note that the carbonized material is still considered as a kind of rice bran ceramics. Since Horikirigawa's composition is substantially the same as Applicants', both should have the same surface properties, such as lubrication. The amount of the rice bran ceramics is described in [0013]. For Claim 9, the coating composition can certainly be capable of forming a dry film by proper adjusting the viscosity of the composition and number of coatings.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Horikirigawa.

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Horikirigawa discloses a coating composition, *supra*, which is incorporated herein by reference. Horikirigawa is silent on the particle size of the rice bran ceramics. However, the particle size will affect the viscosity and the processibility of the coating composition. In other words, the particle size is a Result-Effective variable. Therefore, it would have been obvious to one of ordinary skilled in the art at the time of the invention was made to utilize a rice bran ceramics having whatever particle size through routine experimentation in order to obtain a coating composition with desired properties such as viscosity and processibility. Especially, Applicants do not show the criticality of the particle size. See MPEP 2144.05 (II).

8. Claim 4 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Horikirigawa does not teach or fairly suggest the use of an **acrylsilicone resin**.

Allowable Subject Matter

9. Claims 5-8, 10 and 12 are allowed.

10. The following is an examiner's statement of reasons for allowance:

The present claims are allowable for at least the following reason(s) over the closest reference: Horikirigawa does not teach or fairly suggest the sliding member having a **dry film** set forth in the instant claims.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuo-Liang Peng whose telephone number is (571) 272-1091. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski, can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on

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access to the Private PAIR system, contact the Electronic Business Center (EBC)
at 866-217-9197 (toll-free).

klp

March 3, 2006



Kuo-Liang Peng
Primary Examiner
Art Unit 1712